

AMENDMENT UNDER 37 C.F.R. § 1.116
U.S. Appln. No. 09/707,963

REMARKS

Claims 1-23 and 25-29 are all the claims pending in the Application. By this Amendment, Applicant amends claims 1 and 12 to include the features similar to some of the features recited in claim 20.

I. Preliminary Matters

The Examiner has not returned the initialed Forms PTO/SB/08 submitted with the Information Disclosure Statements filed on July 10, 2003 and March 23, 2005. Applicant respectfully requests the Examiner to initialed Forms PTO/SB/08 and return these forms to the Applicant with the next office communication. For the Examiner's convenience, Applicant encloses a copy of the Forms PTO/SB/08 as filed on July 10, 2003 and March 23, 2005.

II. Summary of the Office Action

Claims 20-23 and 25-29 are allowed. The Examiner, however, retained the prior art rejections of claims 1-19 under 35 U.S.C. § 103(a).

III. Prior Art Rejections

The Examiner rejected claims 1, 3-10, 12, 13, and 16-19 under 35 U.S.C. § 103(a) as being anticipated by U.S. Patent No. 5,355,784 to Hsueh (hereinafter "Hsueh") in view of U.S. Patent No. 5,455,799 to Torrey et al. (hereinafter "Torrey"). Applicant respectfully traverses in view of the following comments.

Of these rejected claims, only claim 1 and 12 are independent. Independent claims 1 and 12 recite some variation of: "wherein said specific multifunction telephone notifies said control unit of a call arrival at said portable radiophone, and in response, said control unit switches the

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specific multifunction telephone from a wired line communication mode to a radio communication mode to answer a call addressed to said portable radiophone via said specific multifunction telephone.” Applicant respectfully submits that at least these unique features of claims 1 and 12 are clearly absent from the combined teachings of Hsueh and Torrey, as acknowledged by the Examiner (see pages 11 to 12 of the Office Action).

Hsueh teaches that the telephone set 1 receiving the signal of the wireless communication network (col. 2, line 61 to col. 3, line 17). In Hsueh, however, there is no disclosure of the telephone set 1 being able to communicate using the wired communication network in addition to the wireless communication network. For example, in Hsueh, there are no control means to switch between the two types of networks. In fact, the purpose of Hsueh’s disclosure is to use the telephone set 1 with a wireless network, where the wired network is not available. In short, Hsueh clearly fails to disclose having a telephone set configured to switch between a wired communication mode and a radio communication mode.

Torrey fails to cure the deficient teachings of Hsueh. Torrey fails to teach or suggest having a telephonic device notify the alleged control unit (premise converter 220) of the received call. In fact, it is the premises converter which forwards the call to an appropriate telephonic device. In short, Torrey fails to teach or suggest a multifunction telephone notifying the control unit of the call which arrived to the portable radiotelephone and, in response, switching from the wired line communication mode to the radio communication mode. Moreover, in Torrey, the portable device is connected to the premise converter 220 and not to the telephonic device. As a result, Torrey clearly fails to cure the deficient teachings of Hsueh.

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Therefore, “wherein said specific multifunction telephone notifies said control unit of a call arrival at said portable radiophone, and in response, said control unit switches the specific multifunction telephone from a wired line communication mode to a radio communication mode to answer a call addressed to said portable radiophone via said specific multifunction telephone,” as set forth in some variation in claims 1 and 12 is not suggested or taught by the combined teachings of Hsueh and Torrey, which lack having the specific multifunction telephone notifying a control unit of a call arrival at the portable radiophone and a telephone set capable of switching between wired and radio communication modes. For at least these exemplary reasons, Applicant respectfully submits that independent claims 1 and 12 are patentable over the combined teachings of Hsueh and Torrey. Applicant, therefore, respectfully requests the Examiner to reconsider and withdraw this rejection of independent claims 1 and 12. Claims 3-10, 13, 14, and 16-19 are patentable at least by virtue of their dependency on claim 1 or 12.

Next, dependent claims 2, 11, and 15 are rejected under 35 U.S.C. § 103(a) as being unpatentable over the combined teachings of Hsueh, Torrey, and applicant prior art (hereinafter “APA”). Claims 2, 11, and 15 depend on claim 1 or 12. It was already demonstrated that the combined teachings of Hsueh and Torrey do not teach or suggest all of the unique features of claims 1 and 12. Applicant respectfully submits that APA teaches that a multifunction telephone cannot receive calls addressed to a radiophone. Therefore, APA fails to teach or suggest a multifunction telephone notifying a control unit of a call received by the radiophone and the control unit switching the multifunction telephone to a different communication mode. As such

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APA clearly fails to cure the deficient teachings of Hsueh and Torrey. Accordingly, claims 2, 11, and 15 are patentable at least by virtue of their dependency.

IV. Allowed Claims

Applicant thanks the Examiner for allowing claims 20-23 and 25-29.

V. Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue, the Examiner is kindly requested to contact the undersigned attorney at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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